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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/755,744   | 01/12/2004  | Heribert Lorenz      | 101216-36           | 9582             |
| 27387  | 7590        | 05/07/2004           | EXAMINER            |                  |
| BRUCE LONDA<br>NORRIS, MCLAUGHLIN & MARCUS, P.A.<br>220 EAST 42ND STREET, 30TH FLOOR<br>NEW YORK, NY 10017 |             |                      | ELHILO, EISA B      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1751                |                  |

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |  |
|------------------------------|-------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/755,744 | Applicant(s)<br>LORENZ ET AL. |  |
|                              | Examiner<br>Eisa B Elhilo     | Art Unit<br>1751              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/11/2004</u>   | 6) <input type="checkbox"/> Other: _____                                    |

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Claim 1 is pending in this application.

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities:

Instant claim 1 is objected to for containing improper Markush language. The examiner suggests that the phrase "selected from the group" should be rewritten as "selected from the group consisting of A, B and C" to meet the proper Markush language requirement. See MPEP 2173.05(h)(I). Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/465078, over claim 1 of copending Application No. 10/465278, over claim 1 of copending Application No. 10/730,469, over claim 1 of copending Application No. 10/642,917 and over claims 1 and 2 of copending Application No. 10/465,304. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the claims of the co-pending Applications No. 10/465278, 10/730,469, 10/642,917, 10/465078 and 10/465304 teach and disclose similar hair dyeing compositions on the basis of an oxidation dyestuff precursor reacting with peroxide wherein the compositions comprise at least one developing and/or coupling substance selected from a number of chemical compounds wherein 3-chloro-p-aminophenol and/or 2-methyl-4-methoxy-5-hydroxyethyl aminophenol and/or 2-methyl-5-methyl aminophenol compounds are among the selected compounds as claimed in the instant claim 1, a), or b), (see claim 1, a), b) and claim 2 of co-pending Application No. 10/465078), (see claim 1, a) of co-pending Application No. 10/465278), (see claim 1, a) of co-pending Application No. 10/730,469), (see claim 1, a), b) and claim 2 of co-pending Application No. 10/465304) and (see claim 1, a) of co-pending Application No. 10/642,917). Therefore, this is an obvious formulation.

Although, the claims of the co-pending Applications No. 10/465,304, 10/465,278, 10/730,469, 10/465078 and 10/642,917 teach and disclose similar hair dyeing compositions, the claims of the co-pending Applications are not identical to the instant claim, because the claims of the co-pending Applications No. 10/465,304, 10/465,278, 10/730/469, 10/465,078 and 10/642,917 do not require that 2,6-dichloro-p-aminophenol compound to be among the selected compounds as required by the instant claim. Therefore, the conflicting claims are not identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tamura et al. (US 5,015,260).

Tamura et al. (US' 260) teaches a hair dyeing composition comprising 2-methyl-4-methoxy-5-aminophenol as claimed in claim 1 (see col. 10, lines 42-57 and Table 1). Tamura et al. (US' 260) teaches all the limitations of the instant claim. Therefore, the claim is anticipated by Tamura et al. (US' 260).

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Henkel KGAA[HENK] (DE 20017642 U1).

Henkel (DE' 642 U1) teaches a hair dyeing composition comprising 2-methyl-4-methoxy-5-aminophenol as claimed in claim 1 (see abstract). Henkel (DE' 642 U1) teaches all the limitations of the instant claim. Therefore, the claim is anticipated by Henkel. (DE' 642 U1).

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Audousset et al. (US 5,578,087).

Audousset et al. (US' 087) teaches a hair dyeing composition comprising 3-chloro-4-aminophenol as claimed in claim 1 (see col. 3, line 55). Audousset et al. (US' 087) teaches all the limitations of the instant claim. Therefore, the claim is anticipated by Audousset et al. (US' 087).

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Golinski Frank (DE 019834657 C1).

Golinski Frank (DE' 657 C1) teaches a hair dyeing composition comprising 2,6-dichloro-4-aminophenol as claimed in claim 1 (see abstract). Golinski Frank (DE' 657 C1), teaches all the limitations of the instant claim. Therefore, the claim is anticipated by Golinski Frank (DE' 657 C1).

### *Conclusion*

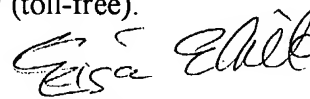
The remaining references listed on from 1449 have been reviewed and considered by the Examiner. Further, the prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. (US 5,104,414), (US 4,865,619), (EP 1250910 A1 Equivalent to DE 10118892 A1) and (DE 10051034 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Eisa Elhilo".

Eisa Elhilo  
Patent Examiner  
Art Unit 1751

May 3, 2004